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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,341	12/12/2001	Yongcai Wang	82662HEC	6168

7590 08/10/2005

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,341

Applicant(s)

WANG ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-15, 17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 4-15, 17-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 20050807
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Applicant's election with traverse of Group I in the reply filed on 5/23/05 is acknowledged. The traversal is on the ground(s) that the inventions are in essence the same. This is not found persuasive because the claims are distinct inventions and restriction is proper for reasons set forth in the prior office action. Additionally, method claims which contain all limitations of an allowable article claim will be rejoined for allowance. Claims 18 and 19 remain withdrawn from further consideration.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1, 4, 6-9, 11-15, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903,246) for reasons of record and for reasons given below. While most of the limitations of claim 20 have been dealt with previously, claim 20 also contains a new limitation, also present in claim 17, that no UV absorber is present. Since the UV absorber of the reference may be inorganic particles that are specifically recited by the instant specification as inorganic particles, such materials may be present consistent with applicants' claims, although the reason for inclusion of the particles differs from the reference and the instant application.

3. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903246) as applied to claim 1 above, and further in view of Chu et al. (6,440,537) for reasons of record and for reasons given above.

4. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903246) as applied to claim 1 above, and further in view of Becker (US 2002/0071019) for reasons of record and for reasons given above.

5. Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive for reasons of record and for reasons set forth herein. The reason for inclusion of inorganic particles is not dispositive of the patentability of the instant claims. The language of the instant claims concerning no UV absorbers cannot be used to exclude materials which applicants' own specification and claims still recite as present in their medium. These inorganic oxides have not been excluded by applicants' new claim language.

Applicants' comparisons have also been considered but are not persuasive. The comparison is not with the closest prior art. The comparisons have no stabilizers and UV absorbers in either the base layer or the ink receiving layer. These media would be expected to differ from the claimed invention in their performance.

In addition, applicants argue that a layer characterized as a base layer cannot be used as an image receiving layer. The examiner disagrees. Unless a definition is set forth by applicants' specification (none appears to have been set forth), the term will be given its usual and broadest meaning in the art. The examiner has studied the art and believes the term "base layer" to indicate any layer near the support that has other layers over it. It may have a variety of functions depending upon its composition and has used to represent a variety of different layers having in common only their relative position in a medium. While applicants have set forth functions their image receiving layer must perform, they have not done so for their base layer. The claimed base layer reads on an additional ink receiving layer of the primary reference (see p. 7). Applicants

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argue that a base layer is intended to serve as an additional sump for the ink solvent.

The additional ink receptive layer of the reference would serve this function.

Applicants also argue the thickness of the base layer would prevent its successful use for imaging with dye. But the base layer of the reference need not be used for holding the image. It may be used as a sump for the solvent and be considered ink receiving. Finally, the primary reference recites weights per area for their layers rather than thicknesses. Determination of the thicknesses of coating layers would have been obvious to one of ordinary skill in the art, but if applicants can demonstrate that the coating weights of the reference will not result in layers within or near to the instantly claimed thickness ranges, this would be considered to teach away from applicants invention.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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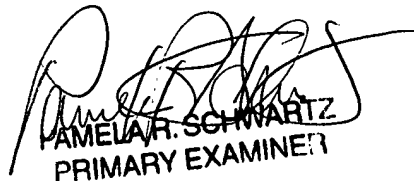
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
August 7, 2005



PAMELA R. SCHWARTZ
PRIMARY EXAMINER